

REMARKS

Claims 1-6, 8-64 and 73-75 are pending in the application. Claims 1-4, 7-11, 13-25, 30-36, 39-52, and 57-64 were rejected. Claims 5, 6, 12, 26-29, 37-38, 43, and 53-56 were objected to as being dependent upon a rejected base claim and were otherwise found to be allowable by the Examiner.

The listing of pending claims above differs from the listing of pending claims provided by the Examiner. In particular, claims 3-6, 12, 26-29, 35-38, 43, 53-56, and 73 were not listed as pending in the Office Action Summary. Applicants invite the Examiner to contact the undersigned if claims 1-6, 8-64 and 73 are not believed to be pending.

Claims 16, 30, 59 and 60 have been amended. Claims 74 and 75 are newly added. Support for the amendments to claims 16 and 59 and for newly added claims 74 and 75 may be found on page 17, last paragraph, through page 18, first paragraph. Support for the amendment to claim 60 may be found on page 15, last paragraph. Support for the amendment to claim 30 may be found on page 18, last paragraph, through page 19, first paragraph. No new matter has been added.

Reconsideration is requested in view of the following remarks.

Response to Rejection Under 35 U.S.C. §112

Claims 16, 17, 30, 59 and 60 were rejected under 35 U.S.C. § 112 as allegedly being indefinite for including a dimension that is relative to a patient's body part. Claims 16, 30, 59 and 60 have been amended and no longer include a dimension that is relative to a patient's body. Claim 17 does not include a dimension relative to a patient's body part. In view of the amendments to the claims, Applicants respectfully request that the rejection under 35 U.S.C. § 112 be withdrawn.

Response to Rejection Under 35 U.S.C. §102

Claims 1-4, 7-11, 13-23, 30, 32-36, 39-50, 58-61 and 64 were rejected under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 6,464,670 to Mulholland (the "Mulholland" patent). Claims 1 and 33 each include a feature neither disclosed nor suggested by the Mulholland patent, namely, "a non-meltable reinforcement" [emphasis added].

The Examiner incorrectly alleges, with regard to claims 1, 33, 61, and 64, that the Mulholland patent discloses “a reinforcement (12) that is non-meltable.” However, in contrast to claim 1, the Mulholland patent neither discloses nor suggests a non-meltable reinforcement.

The suppository of the Mulholland patent is made of a therapeutic agent and a biocompatible carrier medium (see column 7, lines 55-57). Both the therapeutic agent and the biocompatible material are formed of a meltable material. The therapeutic agent is meltable so that it is capable of being absorbed through the mucosal lining of the human female urethra (see column 6, lines 28-30). The biocompatible carrier medium is meltable so that it completely liquefies within the urethra (see column 7, lines 1-3 and 21-24). Therefore, the suppository of the Mulholland patent is entirely formed of a meltable material and does not include a non-meltable reinforcement.

Accordingly, Applicants assert that claims 1 and 33 are not anticipated by Mulholland because Mulholland does not disclose a non-meltable reinforcement. Claims 2-4, 7-11, 13-23, 30, 32, 34-36, 39-50, 58-61 and 64 and newly added claims 74 and 75 depend from claims 1 or 33 and are also novel over Mulholland for the same reasons explained above. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. §102 be withdrawn.

Response to Rejection Under 35 U.S.C. §103

Claims 24, 25, 31, 51, 52, 57, 62 and 63 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Mulholland patent. The Mulholland patent only qualifies as prior art under 35 U.S.C. §102(e). Under 35 U.S.C. § 103(c), subject matter which qualifies as prior art only under 35 U.S.C. 102(e) shall not preclude patentability under 35 U.S.C. §103 if the claimed invention, at the time the invention was made, was owned or subject to an obligation of assignment to the same person.

At the time the claimed invention was made, the claimed invention and the Mulholland patent were owned by or subject to an obligation of assignment to a common owner, namely, BioMed Innovations, LLC. As further evidence of common ownership, enclosed as Appendix C is a Declaration of Common Ownership by the President of BioMed Innovations, LLC. The enclosed declaration is sufficient evidence under MPEP §706.02(1)(2) to overcome the rejection under 35 U.S.C. § 103(a).

Accordingly, Applicants respectfully request that the rejection of claims 24, 25, 31, 51, 52, 57, 62 and 63 under 35 U.S.C. §103(a) be withdrawn.

The claims of the application are believed to be in condition for allowance. An early action toward that end is earnestly solicited.

Respectfully submitted,
S. GRANT MULHOLLAND et al.

BY 

DANIEL A. MONACO
Registration No. 30,480
DRINKER BIDDLE & REATH LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103
Phone: (215) 988-3312
Fax: (215) 988-2757
Attorney for Applicants